

ESTTA Tracking number: **ESTTA181669**

Filing date: **12/18/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	American Racing Equipment, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	19067 South Reyes Avenue Rancho Dominguez, CA 90221 UNITED STATES		

Attorney information	Rochelle D. Alpert Morgan, Lewis & Bockius LLP One Market Spear Tower San Francisco, CA 94105 UNITED STATES ralpert@morganlewis.com Phone:(415) 442-1326
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### Applicant Information

Application No	77024370	Publication date	11/20/2007
Opposition Filing Date	12/18/2007	Opposition Period Ends	12/20/2007
Applicant	Weld, Greg 645 N.E. Shoreline Drive Lee's Summit, MO 64064 UNITED STATES		

### Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Land vehicle parts, namely, wheel rims
Class 035. All goods and services in the class are opposed, namely: Distributorships in the field of automotive parts

### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2086419	Application Date	11/06/1995
Registration Date	08/05/1997	Foreign Priority Date	NONE
Word Mark	WELDWHEELS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1996/06/00 First Use In Commerce: 1996/06/00 distributorship services in the field of automotive wheels

U.S. Registration No.	2166255	Application Date	03/25/1996
Registration Date	06/16/1998	Foreign Priority Date	NONE
Word Mark	WELDWHEELS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1997/09/30 First Use In Commerce: 1997/09/30 vehicle wheels		

U.S. Registration No.	2008430	Application Date	11/06/1995
Registration Date	10/15/1996	Foreign Priority Date	NONE
Word Mark	WELD RACING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1983/12/31 First Use In Commerce: 1983/12/31 automotive vehicle wheels		

U.S. Registration No.	2003222	Application Date	11/06/1995
Registration Date	09/24/1996	Foreign Priority Date	NONE
Word Mark	WELD RACING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1983/12/31 First Use In Commerce: 1983/12/31 distributorship services in the field of automotive wheels		

U.S. Registration No.	2000079	Application Date	11/06/1995
Registration Date	09/10/1996	Foreign Priority Date	NONE
Word Mark	WELD RACING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1983/12/31 First Use In Commerce: 1983/12/31 apparel, namely shirts, caps, shorts, jackets and shoes		

U.S. Registration No.	2226933	Application Date	04/18/1994
Registration Date	03/02/1999	Foreign Priority Date	NONE
Word Mark	WELD EVO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1994/02/09 First Use In Commerce: 1994/02/09 automotive wheels		

Related Proceedings	American Racing Equipment, Inc. v. Richard G. Weld and Greg Weld, Inc., United States District Court for the Western District of Missouri, Western Division, Case No. 4:07 CV 774
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Attachments	75016089#TMSN.gif ( 1 page )( bytes ) NoticeofOppTEAMWELD.pdf ( 7 pages )(228930 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/rda/
Name	Rochelle D. Alpert
Date	12/18/2007

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 77/024,370  
Filed on October 18, 2006  
For the mark TEAM WELD  
Published in the OFFICIAL GAZETTE on November 20, 2007

AMERICAN RACING EQUIPMENT, INC.,

Opposition No.:

Opposer,

v.

GREG WELD,

Applicant.

BOX TTAB – FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

American Racing Equipment, Inc., a Delaware corporation, having its principal place of business at 19067 South Reyes Avenue, Rancho Dominguez, CA 90221 (“ARE”), files this opposition because it believes that it will be damaged by registration of the mark shown in application Serial No. 77-024,370, and hereby opposes the same.

As grounds for the opposition, ARE alleges as follows:

1. ARE and its predecessors in interest, Weld Wheel Industries, Inc., Weld Racing, Inc. and Weld Distribution, Inc. (together the “Weld Companies”), have been recognized designers, manufacturers and suppliers of automotive wheels and related parts and accessories and services for more than thirty (30) years.

2. For more than three decades, ARE and its predecessors in interest have owned and used trademarks and trade names that are comprised of or contain the term “WELD” for automotive wheels and parts and related accessories and services. As a result, these WELD trade names, trademarks and domain names, including, among others, the WELD, WELD RACING, WELD WHEELS, and WELD MOTORCYCLE marks and names (referred to as the “WELD Marks”), have become widely recognized as identifiers of source for the products and services, including, wheels, that ARE and its predecessors in interest have offered and sold.

3. Weld Racing, Inc., one of ARE’s predecessors in interest, owned incontestable federal trademark registrations for the following “WELD” marks:

(a) WELDWHEELS® (Reg. No. 2,166,255) for “distributorship services in the field of automotive wheels,” in International Class 42;

(b) WELD RACING® (Reg. No. 2,008,430) for “automotive vehicle wheels,” in International Class 12;

(c) WELD RACING® and Design (Reg. No. 2,003,222) for “distributorship services in the field of automotive wheels” in International Class 42;

(d) WELD RACING® (Reg. No. 2,000,079) for “apparel, namely shirts, caps, shorts, jackets and shoes,” in International Class 25;

(e) WELD EVO® (Reg No. 2,226,933) for “automotive wheels,” in International Class 12; and

(f) WELDWHEELS® (Reg. No. 2,086,419) for “distributorship services in the field of automotive wheels,” in International Class 42.

These federally registered and incontestable marks are referred to as the “WELD® Trademark Registrations.” The WELD Trademark Registrations have been assigned to ARE. In this regard, ARE has maintained the WELD® Trademark Registrations in its name, including filing documents with the Trademark Office reflecting Weld Racings, Inc.’s assignment of its entire interest in the Trademark Registrations to ARE. Accordingly, ARE properly is listed as the owner of the Trademark Registrations with the Trademark Office.

4. On September 28, 2006, Greg Weld, one of the owners of the Weld Companies and the applicant for the subject application, sold and transferred through a bankruptcy proceeding, ownership of all of the assets of the Weld Companies, including all rights, interest and title in and to, and the goodwill associated with, the WELD Marks and the WELD® Trademark Registrations to ARE for over \$20 million. The sale also included the transfer to ARE of WELD based domain names, including “weldracing.com,” “weldmotorsports.com,” and “weldmotorcycle.com” (referred to as the “WELD Domain Names”).

5. Since its acquisition of the Weld Companies and all of their intellectual property in 2006, ARE has used the WELD Marks, the WELD® Trademark Registrations, and the WELD Domain Names in connection with its automobile wheels and related parts and accessories and services.

6. As a result of ARE’s ownership and continuous use of the WELD Marks, the WELD® Trademark Registrations, and the WELD Domain Names for its automobile wheels and related parts and accessories and services, these WELD marks and names have become identified and associated with ARE and its products and services.

7. Despite the Weld Companies' sale of all their intellectual property and the express terms of the governing agreement, on October 18, 2006, in direct violation of the agreement, Applicant Greg Weld ("Applicant") filed the opposed intent-to-use application seeking to register the confusingly similar designation TEAM WELD for products and services that, on their face, are directly competitive with the products and services for which ARE's WELD marks have been, and continue to be, used and registered. In this regard, the opposed application seeks registration of the confusingly similar TEAM WELD designation for "[l]and vehicle parts, namely, wheel rims," in International Class 12, and "[d]istributorships in the field of automotive parts," in International Class 35. ARE's rights in and to the WELD Marks, the WELD Trademark Registrations, and the WELD Domain Names all predate by many years the October 18, 2006 filing date for the opposed intent-to-use application.

8. The designation for which Applicant seeks registration by way of the opposed application contains the identical and dominant WELD component as the WELD marks, the WELD Trademark Registrations, and the WELD Domain Names that Applicant, as an officer of the Weld Companies, effectively sold to ARE for substantial consideration, and which ARE owns and has used, and continues to use, as an identifier of source for its products and services.

9. The goods and services for which Applicant seeks to register the confusingly similar TEAM WELD designation are competitive with or, at the very least, directly related to and/or complementary to, the products and services ARE and its predecessors in interest long have offered and promoted under the WELD Marks, the Registered WELD® Marks, and the WELD Domain Names. Moreover, ARE alleges that Applicant intends to market, promote, and direct his products and services offered under the confusingly similar TEAM WELD designation to the same and/or overlapping customers to whom ARE and its predecessors in interest long


have directed and sold their products and services under the WELD Marks, the Registered® WELD Marks and the WELD Domain Names. ARE further alleges that Applicant will use the same or overlapping channels of trade that ARE and its predecessors in interest have long used for their WELD products and services to reach the same or overlapping prospective customers. Indeed, the goods and services in Applicant's application are not limited in anyway as to channels of trade or prospective customers.

10. Inasmuch as the dominant portion of ARE's WELD marks and names are essentially identical in terms of sight, sound and meaning to the dominant term of Applicant's proposed designation, and because the goods and services identified in the opposed application are competitive with or, at the very least, are directly related or complementary to, ARE's WELD products and services, and since the apparent channels of trade and prospective customer base for Applicant's competitive and/or related products and services will overlap with the customer base and channels of trade long used by ARE and its predecessors in interest for their products and services, Applicant's applied-for mark is likely to cause confusion, or to cause mistake, or to deceive or disparage by falsely suggesting a connection with ARE, when there is none. As a result, ARE will be damaged by the registration of the designation in Applicant's application and requests that registration of the opposed application be denied.

WHEREFORE, on the grounds alleged above, ARE prays that registration of application Serial No. 77/024,370 be refused and denied, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of ARE.

Dated: December 18, 2007

Respectfully submitted,

By:   
Leslie C. McKnew  
Attorney for Opposer  
American Racing Equipment, Inc.

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Leslie C. McKnew  
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**PROOF OF SERVICE**

I, Yelena Lolua, am a resident of the State of California and over the age of eighteen years, and not a party to the within action; my business address is One Market, Spear Street Tower, San Francisco, CA 94105.

On **December 18, 2007**, I served the within documents:

**NOTICE OF OPPOSITION**

on the party(ies) listed below:

**PARTY SERVED**

**Greg Weld  
645 N.E. Shoreline Drive  
Lee's Summit, MO 64064**

**METHOD OF SERVICE**

**FIRST CLASS MAIL**

**Michael A. Williamson  
Polsinelli Shalton Welte Suelthaus PC  
700 W 47th Street, Suite 1000  
Kansas City, MO 64112-1805**

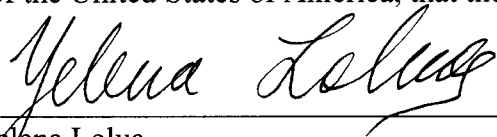
**FIRST CLASS MAIL**



(BY MAIL) I placed the sealed envelope(s) for collection and mailing by following the ordinary business practices of Morgan, Lewis & Bockius LLP, San Francisco, California. I am readily familiar with the firm's practice for collecting and processing of correspondence for mailing with the United States Postal Service, said practice being that, in the ordinary course of business, correspondence with postage fully prepaid is deposited with the United States Postal Service the same day as it is placed for collection.

Executed on **December 18, 2007**, at San Francisco, California.

I declare under penalty of perjury, under the laws of the United States of America, that the foregoing is true and correct.

  
\_\_\_\_\_  
Yelena Lolua